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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,779	09/27/2005	Jacques Thibaut	THIBAUT2	1785

7590 04/23/2007
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EXAMINER

COURSON, TANIA C

ART UNIT	PAPER NUMBER
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2859

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/550,779

74
Applicant(s)

THIBAUT ET AL.

Examiner

Tania C. Courson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09JAN07 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>09JAN07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “so that when the detectors break contact with the bar” as stated in lines 3-4 of claim 11, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 1 is objected to because of the following informalities: it is unclear what is connected or in contact with “a second yoke”, also how is there a “free end of the bar” when it appears that in Figures 3 or 5, the detectors (6 & 7) connect the bar (3) to the fixed frame (5). For examination purposes, the examiner has assumed that the “free end” is simply “the other end of the bar” as it appears in Figures 3 or 5. Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (US 6,884,204 B2) in view of Lessi et al. (US 5,009,512).

Watanabe discloses a measuring system including the following:

- a) a spindle (12) for receiving the tool (W), wherein the spindle is capable of movement for interacting with the measuring device (19) for deducing for deducing the dimensions of the tool according to a measuring system (19) specific to said spindle (Fig. 1), and wherein the measuring device comprises a bar (13a) made of a material (Fig. 1), wherein one end of the bar is fixedly attached to a first yoke attached to a fixed frame (Fig. 1) and an opposite free end of the bar is in contact with a detector (19a) and to a second yoke (14) capable of sliding on the bar (Fig. 1) and wherein a platform (15) overhangs the second yoke (Fig. 1);
- b) the detector is connected to the measuring system (Fig. 1) specific to the spindle, so that when the detector breaks contact with the bar, the dimensions of the tool are deduced (Fig. 1).

Watanabe does not disclose a flexible bar having highly elastic properties and made of elastic steel, a bar has a square cross section and wherein a platform includes a beveled edge, wherein a detector comprises two detectors, placed perpendicular to one another and wherein the detectors are micrometric end-of-travel detectors; one of which is placed vertically, for

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determining a length and another one of the detectors is placed horizontally, for determining a diameter.

Regarding claim 6: It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Therefore, one skilled in the art would use an alternate location for resting the tool in order to suit the needs of the user of the device.

Regarding claims 6 and 8: Watanabe discloses a bar (13a) having a material (Fig. 1). The particular type of material used to make the bar, absent any criticality (i.e. flexible, highly elastic properties, elastic steel), is only considered to be the use of a “ preferred ” or “optimum” material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant’s apparatus, i.e., suitability for the intended use of Applicant’s apparatus. See *In re Leshin*, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious. Therefore, one skilled in the art would change the type of material of the bar in order to suit the needs of the user of the device.

Lessi et al. teach a measuring device that consists of wherein a detector comprises two detectors (4), placed perpendicular to one another and wherein the detectors are micrometric end-

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of-travel detectors (6); one of which is placed vertically (Fig. 3), for determining a length and another one of the detectors is placed horizontally, for determining a diameter (Fig. 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the measuring system of Watanabe, so as to replace the detector of Watanabe, with the micrometric detectors, as taught by Lessi et al., because both are well known alternate types of detectors which will perform the same function, if one is replaced with the other, of detecting distance.

With respect to claim 7: the shape of the bar (i.e., having a square cross-section), absent any criticality, are only considered to be obvious modifications of the shape of the bar (13a) disclosed by Watanabe as the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by Applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide using routine experimentation based on its suitability for the intended use of the invention. See *In re Dailey*, 149 USPQ 47 (CCPA 1976). Therefore, one skilled in the art would change the shape of the bar in order to suit the needs of the user of the device.

With respect to claim 12: the shape of the platform (i.e., having a beveled edge), absent any criticality, are only considered to be obvious modifications of the shape of the platform (15) disclosed by Watanabe as the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by Applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find

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obvious to provide using routine experimentation based on its suitability for the intended use of the invention. See *In re Dailey*, 149 USPQ 47 (CCPA 1976). Therefore, one skilled in the art would change the shape of the platform in order to suit the needs of the user of the device.

Response to Arguments

5. Applicant's arguments filed on January 9, 2007 have been considered but are moot in view of the new ground(s) of rejection.
6. Regarding the argument that the type of material is critical, the applicant's specification does not support this claim.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The prior art cited on PTO-892 and not mentioned above disclose a measuring device:

Mies et al. (US 7,117,609 B2)

Radowick (US 6,546,616 B2)

Washio et al. (US 5,953,127)

Kitamura (US 4,976,019)

Buchler (US 4,822,014)

Holy et al. (US 4,774,753)

Sterki (US 4,532,715)

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Graham (US 2,752,687)

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tania C. Courson whose telephone number is (571) 272-2239. The examiner can normally be reached on Monday, Tuesday and Thursday from 9AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez, can be reached on (571) 272-2245.

The fax number for this Organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TCC
April 13, 2007



Diego Gutierrez
Supervisory Patent Examiner
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